

Remarks

This paper seeks to place the application in condition for allowance or appeal, in response to the final Office Action dated April 16, 2004.

Applicant changes the title of the application to correspond to the elected claims and better correspond to the subject matter of the claims as amended. In particular, not all claims are directed to medical subject matter. With respect to the new title, some claims merely include receiving digital information blocks, while others have marketplace components. Applicant reminds the examiner that claim preambles do not limit the claim scope unless referenced in the body of the claim in such a way that they are necessary to understanding the claim body.

In the claims, applicant has made no changes except to correct typographic errors in claims 3 and 113 and to cancel claims 4-8, 45-47, 65-69, and 94-98. The purpose of canceling those claims is merely to simplify issues in the case, without prejudice. A continuation and a divisional application are planned.

The amendment is proper under Rule 116, because it merely changes the title and corrects typos (housekeeping matters) and cancels claims. It should be entered even though this application stands pending after final rejection.

The only rejection in the final Office Action not mooted by this amendment is the rejection of all claims as anticipated by (or in the case of certain dependent claims obvious over) U.S. Patent 5,136,501 to Silverman (with the addition of a supporting reference with respect to two dependent claims).

Although applicant has canceled former independent claim 4, applicant notes that the final Office Action did not apply Silverman to reject claim 4. Applicant believes that the reason Silverman was not applied lies in the final paragraph of claim 4, "wherein the system is configured in such a manner as to enable the diagnostic service provider to select one or more of the digital medical images from the database for reading from the

listing, at the discretion of the diagnostic service provider." Silverman plainly does not disclose having the provider select one of the images from a database.

A parallel distinction applies to all of the remaining claims, distinguishing Silverman and requiring allowance of this application. Silverman discloses a system in which the central computer *automatically* matches bids and offers. By contrast, in applicant's system disclosed in the specification, the central computer merely presents a listing of the bids, and the service provider (i.e., the seller, in some embodiments, a radiologist) affirmatively elects to select a bid and accept the accompanying digital information block for analysis.

Not all details of applicant's disclosed system (of course) are included in the claimed inventions, but each of the claims contain language capturing this basic distinction. Applicant discusses each of the independent claims in turn below.

Claim 1 states that "one of said second users *elects* to receive a *selected* one of said digital information blocks responsive to said indicia" of priority (which may be a bid price). In Silverman, the sellers (which the Office Action treats as the "second users") would not make any election or selection, because Silverman's system would automatically match bids and offers.

Claim 29 includes "a third computer system for *selecting the selected one* of the respective work orders"

Claim 35 specifies that "the system is configured in such a manner as to enable any one or more of the service providers to *select and extract* one or more of the work orders from the work order database"

Claim 39 states that "all of the digital information blocks are *freely selectable* by at least one of the respective users."

Claim 70 states that the graphic user interface is arranged "to thereby permit any buyer to select any offer to sell and *any seller to select* any offer to buy."

Claim 103 recites: "each of the third users is presented with a link list ordered responsive the indicia associated with the links stored in the buffer memory and *permitted to select any* of the links."

Claim 107 specifies a "GUI permitting any of the third users to *select* any of the N electronic information blocks."

In the middle of page 11, the Office Action characterizes applicant's argument as an assertion that applicant lacks a buffer intermediary present in Silverman. Those comments misapprehend the argument. Both applicant's disclosed system and Silverman's patent contain an intermediary buffer/computer, but the point is that Silverman's computer performs automatic matching while applicant's buffer does not.

At the bottom of page 11, the Office Action attempts to argue that Silverman discloses the "selection capability" of the claims because, in Silverman:

"the central station book of FIG. 4 displays all of the offers and bids that reside within the entire network. The keystation book, such as shown in FIG. 5, only displays a selected portion of those offers and bids, based on a designated 'display depth'. Thus, the keystation books selects and extracts only certain offers and bids for display, and does not display all of the offers and bids."

Respectfully, that argument does not match the limitations in the claim language.

Silverman's "keystation book" is a display at a user workstation, and the "display depth" is the number of bids and offers shown there. Silverman specifies that "the display depth of the keystation book is controlled by the host computer 20" (*i.e.*, the "central system"). Silverman, col. 10, lines 9-11. However, Silverman adds, "In reality, there are two controls on the display depth, one is a central control by the host computer 20 which determines the maximum possible display depth for the keystation book, and the keystation 24 itself which, within that maximum parameter, can further limit the display depth of the book." Silverman, col. 10, lines 15-20.

In each of applicant's claims, as shown above, it is the "user/service provider/seller" who is permitted to select one of the digital information block (or link thereto). Silverman fails to disclose allowing user control over the display depth

parameter – rather it seems that the central computer 20 and the keystation 24 set the depth automatically. Even assuming *arguendo* that Silverman could be interpreted to disclose user control of keystation 24 to set the display depth at a particular station, that does not match the claim language, wherein the user selects one of the digital information blocks (or a link). Under that assumption about Silverman, the display depth parameter would be selected once, without regard to what blocks/links were being displayed – in other words, the user would simply select the number three for the depth (for example), without knowing what blocks/links would (later) qualify as the top three.

Finally, the Office Action asserts at page 12 that the wording of the distinction in claims 70 and 107 in particular is directed to “an intended usage of an apparatus, thus carrying no patentable weight.” Applicant disagrees.

Claim 107 does not merely recite an intended usage. That claim specifies a storage medium that contains computer readable instructions that cause a computer to generate a GUI having certain claimed characteristics, one of which is the limitation that the GUI must be arranged such as to permit the users to select any of the blocks.

As to claim 70, the limitations in the “whereby” element are intended as claim limiting. The doctrine of file wrapper estoppel now requires interpretation of the claim such that the limitations are not devoid of patentable weight. The claim specifies that “the GUI displays the graphic indicators for *all* offers to buy and sell,” and that is also not an intended use of the apparatus but rather a limitation on the GUI’s structure. And, if all indicators are displayed, then it necessarily follows that the users can select any of the offers, as is made clear by the claim language following “thereby.”

In any event, if necessary, applicant would accept any reasonable suggestion or examiner’s amendment for how to re-word the limitations of claim 70 so that they have patentable weight, as it is intended that they should positively limit the claim. Language parallel to that formerly in canceled claim 4 would do: “wherein the GUI is configured to display the graphic indicators in such a manner as to enable any seller to select any offer

to sell, at the discretion of the seller." Alternatively, the word "wherein" could be substituted for "whereby." Applicant respectfully requests the examiner's guidance on that issue.

Having removed all issues other than the rejections based on Silverman, and having demonstrated a distinction from Silverman tracked in the language of all independent claims remaining, applicant respectfully solicits prompt reconsideration and allowance of this application.

If the Examiner has any questions, please feel free to call applicant's undersigned attorney.

Respectfully submitted,

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by his attorney

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